

09/522,085
Art Unit 3692
9137.00

REMARKS

This Amendment is submitted in response to the Office Action mailed on December 29, 2006. Claims 1 - 8, 22, 23, and 25 - 29 are pending, and all stand rejected at present.

Response to Obviousness Rejection of Claims 1 - 8, 22, 23, and 25 - 29.

Point 1

PDA of Suer does not Act as Cell Phone.
PDAs Now Exist Which Act as Cell Phones.
But those are not Usable as Prior Art.
They Do not Precede Applicant's Filing Date.

The Office Action asserts that the PDA of Suer is equivalent to the claimed cell phone. However, Applicant points out that PDAs which existed at the time Applicant filed his invention required **A CELL PHONE TO BE ADDED TO THE PDA.** The cell phone communicated with the PDA using the Bluetooth (TM) protocol, for example.

Today, PDAs may be available which also act as cell phones, such as the Treo (TM) "smartphones" available from Palm, Inc. (Web site: palm.com.) However, those PDAs are not available as prior art. They have not been shown in the prior art before Applicants' filing date.

Certain accessories which can be added to ordinary PDAs may qualify as prior art. For example, one can today purchase an accessory which allows a PDA to operate with a cell phone, to

09/522,085
Art Unit 3692
9137.00

retrieve e-mail. (A Google search of "palm pilot cell phone accessory bluetooth" produces numerous hits, indicating where such accessories can be purchased.)

Such accessories clearly show that a PDA and a cell phone are separate entities, which perform different functions. For example, if you wanted to order a pizza using the PDA-cell phone combination, you would use the cell phone alone. The PDA could not do that.

Therefore, for the prior art which is available to be cited against the present application, PDAs and cell phones are separate entities, which perform different functions.

The PDA in Suer is not a cell phone.

The Treo Smartphones may qualify as PDAs which also act as cell phones. But they are not prior art.

Point 2
Even if References are Combined, Invention is not Attained

The Office Action, page 3, bottom, asserts that it is obvious to "include a wireless telephone in the system of Suer."

However, if you do that, you do not obtain the present invention.

That is, the Office Action asserts that Suer teaches, during manufacture of an ATM, including a device for communicating with a PDA. The Office Action asserts that this amounts to a teaching

09/522,085
Art Unit 3692
9137.00

for including a cell phone too.

Even if that be true, that does not show the claimed invention.

The claims recite **retro-fitting** an existing ATM which is operative in a public place. Suer's **manufacturing** of an ATM containing a cell phone, as proposed by the PTO, does not show the claimed invention.

Point 3
No Teaching Given for Adding Cell Phone to Suer

The Office Action, page 3, first paragraph, second-to-last sentence, asserts that it is obvious to add a cell phone to Suer. However, no actual reason for doing so is given.

What is given is a **statement of what the cell phone supposedly accomplishes** (attracts many types of users etc.) But that is not a teaching for adding the cell phone in the first place. That is merely a **description of properties of** the combination of references.

Further, this goal (of attracting many types of users) has not been shown in the prior art. The MPEP, as explained in the next section, requires the teaching to be shown in the prior art.

Point 4
PTO is Using Applicant's Own Teaching

One rationale given by the PTO for combining a cell phone with

09/522,085
Art Unit 3692
9137.00

Suer's ATM is "to attract many types of users or customers having different types of portable devices." (Office Action, page 3, end of first paragraph.)

However, Applicant's Specification states that one goal of Applicant's invention is to allow different users, each with a cell phone familiar to the user, to use unfamiliar ATMs.

See the third paragraph of Background of the Invention, which states:

There are a number of different ATM manufacturers, and each manufacturer produces a different style of ATM. In addition, each manufacturer generally has a range of ATM styles, depending on the level of functionality provided by the ATM. This gives rise to a plethora of different types of user interfaces. Users of an ATM may have to spend time familiarizing themselves with the layout of the ATM before they feel confident enough to use the ATM.

See also the third paragraph of Summary of Invention, which states:

By virtue of this aspect of the invention, an ATM may be modified so that a user can withdraw cash using a wireless telephone, such as a cellular telephone. Thus, a user is able to use the user interface associated with his/her telephone rather than the user interface provided by the ATM. This enables a user to use the same user interface (that of his/her telephone) regardless of the make or style of ATM that they are using. By allowing a user to use his/her wireless telephone,

09/522,085
Art Unit 3692
9137.00

privacy is improved because a third party will have more difficulty in viewing information presented on the telephone's display than on the ATM's display. Furthermore, environmental issues can be greatly obviated by allowing a user to bypass, in whole or in part, the existing touch input mechanism.

Therefore, Applicants submit that the rationale used by the PTO is the same as, or similar to, the rationale given in Applicants' Specification.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . . .

The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

Applicants submit that the PTO is using Applicant's own Specification as a teaching, which is forbidden by this MPEP section. This conclusion is supported by the fact that the PTO has not shown an independent source of its rationale.

09/522,085
Art Unit 3692
9137.00

Point 5

PTO Classifies Suer's PDA as "Wireless Device"
And Says Cell Phone is Also "Wireless Device."

Thus, in Essence, PTO States that "Wireless Device" is GENUS
And PDAs and Cell Phones are Both Species.

It is Axiomatic that the Presence of a Genus in the Prior Art
Does not Preclude a Patent on a Species,
Nor does the Presence of a Species in the Prior Art
Preclude a Patent on Another Species.

The Office Action, page 3, first paragraph, third-to-last sentence, states:

The Examiner asserts that the device of Suer
. . . is a wireless device

and

that wireless devices include PDA's and cell
phones . . .

Thus, the PTO states that (1) "wireless device" is the genus,
(2) PDAs are a species, and (3) cell phones are a species.

MPEP § 2144 states:

. . .

The patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. 103.

"The section 103 requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions." [Citation.]

09/522,085
Art Unit 3692
9137.00

The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.");

This MPEP section states that the PTO must

2. Ascertain the Differences Between the Prior Art Genus and the Claimed Species or Subgenus

Once a relevant prior art genus is identified, Office personnel should compare it to the claimed species or subgenus to determine the differences. Through this comparison, the closest disclosed species or subgenus in the prior art reference should be identified and compared to that claimed. Office personnel should make explicit findings on the similarities and differences between the closest prior art reference and the claimed species or subgenus including findings relating to similarity of structure, chemical properties and utilities.

. . . .

4. Determine Whether One of Ordinary Skill in the Art Would Have Been Motivated To Select the Claimed Species or Subgenus

In light of the findings made relating to the three Graham factors, Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus.

09/522,085
Art Unit 3692
9137.00

Therefore, under this MPEP section, the mere fact that cell phones and PDAs are wireless devices is insufficient to reject the present claims. The PTO must provide a teaching as to why one would be motivated to replace the PDA in Suer by a cell phone.

Further, Applicants submit that section (2) of this MPEP section is not being followed. The Office Action asserts that cell phones are "wireless devices" and, based on that similarity with PDAs, are equivalent to PDAs.

However, that is contrary to section (2), which requires the PTO to analyze the "differences," meaning **ALL** "differences." Pointing to a **single SIMILARITY** fails to analyze any "differences" at all.

Further still, section (2) explicitly states:

Office personnel should make explicit findings on the **similarities and differences** between the closest prior art reference and the claimed species or subgenus.

The Office Action has not done this.

Point 6

The mere fact that cell phones and PDAs share a common feature (both being wireless), as a matter of logic, is not a reason for concluding that it is obvious to replace a PDA by a cell phone.

Cell phones and PDAs have different properties. This has been

09/522,085
Art Unit 3692
9137.00

explained in Applicants' previous responses to previous Office Actions.

Further, if this reasoning is valid, then every invention would be obvious.

-- Every device which could be classified as a "machine" could then be substituted for any other "machine" in another reference in an obvious rejection.

-- Every compound classified as "organic" could replace any other "organic" compound, and so on.

Point 7

The Office Action is, in effect, asserting that PDAs are equivalent to cell phones. But MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

The equivalency, as recognized in the prior art, has not been shown.

Further, Applicants submit that such an equivalence would be impossible. As explained above, one can obtain attachments which

09/522,085
Art Unit 3692
9137.00

allow a PDA to cooperate with a cell phone, to retrieve e-mail. If a PDA and cell phone were "equivalent," then no such attachment would be necessary.

Point 8

Office Action Contains Incorrect Statements

The Office Action, page 5, end of first paragraph, states that the modified ATMs "still . . . perform in the same manner before and after modification."

That is not correct, and the very terms of the statement are self-contradictory.

If the ATM is "modified" (and the statement agrees that the ATM is "modified,") then it has been **changed**. It cannot "perform in the same manner" as before.

This applies to the statement on page 3, end of first paragraph. If one replaces Suer's PDA with a cell phone, then Suer's system has **different properties**. It now responds to a cell phone, and does not respond to a PDA.

By analogy, the PTO is saying that, if you change the locks on your house, you have not changed anything. But, after the locks have been changed, you cannot get into the house using the old keys. The house now has different properties.

In Suer, if you change the device needed to communicate with Suer, you thereby change the properties of Suer's system.

09/522,085
Art Unit 3692
9137.00

Point 9

Office Action is not Evaluating Invention "As Whole"

Section 103 requires that the invention "as a whole" be shown as obvious. That has not been done.

When one distills the rejection down to its essence, one sees that the Office Action only asserts that

1) Suer shows a PDA in an ATM, and thus suggests a cell phone in an ATM (page 3, center of page)

and

2) the rest of the claim recitations merely set forth "the usual functions of ATMs." (page 5, line 5.)

However, that does not consider the claims **as a whole**.

The claims state that a functioning ATM in a public place is retro-fitted with a cell phone.

Suer does not install a cell phone in an ATM which is located in a public place.

The claims have never been addressed by the Office Action.

Again, as stated above, the Office Action merely asserts that

1) Suer shows a cell phone in an ATM, by virtue of showing a PDA in an ATM
and

09/522,085
Art Unit 3692
9137.00

2) the rest of the claim recitations merely
set forth "the usual functions of ATMs."

That does not consider the claims **as a whole**, which recite retro-fitting an ATM located in a public place. Such retro-fitting has never been shown in the prior art.

Comment 1

The discussion above applies to page 5 of the Office Action.

Comment 2

The Office Action, page 4, bottom, asserts that the "wherein" clauses fail to recite steps or functions.

Applicants point out that, even if that be so, that is not a basis for ignoring the "wherein" clauses. "Wherein" means "in which." The language following the clause sets forth characteristics of claim elements which have been previously recited.

For example, in claim 8, the "wherein" clause sets forth characteristics of the ATMs, before and after, the modification. Those are claim limitations. If an infringing device does not meet the limitations, then literal infringement is not present.

Further, the Office Action asserts that the "wherein" clauses merely set forth an intended use. Applicants request an explanation of that because, as just explained, the wherein clause

09/522,085
Art Unit 3692
9137.00

of claim 8 sets forth characteristics of the ATMs which are claimed.

Applicants point out that the objection to setting forth an "intended use" is that no objective measure of whether the "intended use" is present. For example, suppose a hypothetical inventor discovered that the claws on an ordinary claw hammer can make an ideal pair of dents in steel, which serve some useful purpose A. Suppose the inventor attempts to claim an ordinary claw hammer, having claws "intended for useful purpose A."

That is objectionable, because nobody can look at a claw hammer, and determine whether the claimed "intent" is present.

That is not so in the present case. The "wherein" clause sets forth characteristics of claim elements.

Finally, as explained above, the Office Action asserted that the "wherein" clauses fail to state "steps or functions." MPEP § 608.01(n) states:

The fact that the independent and dependant claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependant claim.

Thus, a single claim can contain both steps and apparatus. The "wherein" clauses are allowed to add apparatus limitations to a method claim.

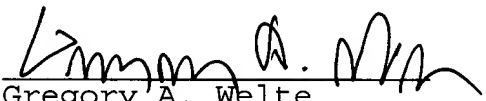
09/522,085
Art Unit 3692
9137.00

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 3
Dayton, OH 45479
April 30, 2007

(937) 445 - 4956